

The opinion in support of the decision being entered today was *not* written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASATOSHI KAWANABE

Appeal No. 1998-1937
Application No. 08/518,509

HEARD: JANUARY 18, 2001

Before CALVERT, STAAB, and NASE, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 3 and 5 as amended by amendments filed subsequent to the final rejection.¹ Claims 2, 4, and 6, the only other claims remaining in the application, have been

¹Three such amendments filed subsequent to the final rejection have been submitted. The amendment filed October 10, 1997 (Paper No. 12) has not been entered. The amendment filed January 30, 1998 (Paper No. 17½) canceling finally rejected claim 1 and amending claims 3 and 5 has been entered. The amendment filed April 10, 1998 (Paper No. 21) amending claim 3 has also been entered.

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withdrawn from

further consideration under 37 CFR § 1.142(b) as not being readable on the elected species.

Appellant's invention pertains to "an overhead door suspended from the top of an opening of a cabinet or the like and capable of being lifted until it is placed on the roof wall of the cabinet to keep the door open" (specification, page 1). A further understanding of the invention can be derived from a reading of exemplary claim 3, a substantially correct copy of which appears in an appendix to appellant's main brief.²

The references relied upon by the examiner as evidence of obviousness are:

Holmes 1945	2,388,654	Nov. 6,
Ferris 1945	2,390,086	Dec. 4,
Carson et al. (Carson) 1996	5,524,979	Jun. 11,

²In the copy of claim 3 found in the appendix to appellant's main brief, line 7, "said one of the corresponding stays" should read --said corresponding one of the stays--.

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(filed Jun. 9,
1994)

The following rejections under 35 U.S.C. § 103 are before
us

for review:³

(A) claim 3, unpatentable over Carson in view of Holmes;

³The rejection of claim 3 under 35 U.S.C. § 112, second paragraph, made in the examiner's answer, has been withdrawn in light of the amendment filed April 10, 1998 (Paper No. 21). See the advisory letter mailed July 24, 2000 (Paper No. 23).

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(B) claim 5, unpatentable over Carson in view of Holmes and further in view of Ferris.

Reference is made to appellant's main and reply briefs (Paper Nos. 17 and 20), and to the final rejection and examiner's answer (Paper Nos. 10 and 18) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

Carson, the examiner's primary reference, discloses an overhead storage cabinet comprising a door mechanism in which combination spring loaded hinge and slide mechanisms 26 mount the cabinet door to the cabinet such that the door may be moved to an open position (see Figure 4) over the cabinet top surface. More specifically, each hinge and slide mechanism includes a first track member 34 secured to a hinge plate 32 and a second track member 38 secured in a recess (not numbered) in the back of the door. A plurality of ball bearings 40 are carried on bearing races 36, which locate the balls between the track members to permit sliding movement of the track members relative to each other. See column 3, lines

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6-26. Each hinge and slide mechanism also includes springs 44 to facilitate the opening of the door. Carson states that springs 44 "may be attached between door 12

and cabinet 10, or door 12 and first plate 30, to perform the necessary door assist function" (column 3, lines 39-41).

Carson's door mechanism further includes lid stays 50, respectively mounted to an inner lateral wall surface of the cabinet and the door, to slow the movement of the door. To this end, each lid stay includes an arm 56, a base end of which is secured to a viscous damper mechanism (see, generally, column 3, lines 51-64), and an extended end that is pivotally connected to the door.

Given the above, it is apparent that Carson fails to meet the requirement of claim 3 calling for "a pair of stay holding tension springs, each spring being connected between a point upwardly and forwardly displaced from the base end of a stay on a corresponding one of the inner lateral wall surfaces of the cabinet and a point in a middle portion of the stay." The examiner's reliance on Holmes to cure this deficiency is not well founded.

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Holmes relates to "overhead doors and more particularly to the type of door which is substantially rigid and in closed position is substantially vertical and which moves to [an] overhead substantially horizontal position when open" (column 1, lines 1-5). As explained in column 1, counterbalance springs are

typically used in such doors to facilitate the opening and closing of the door. Of particular interest to Holmes is the provision on a counterbalancing arrangement that does not involve the movement of the counterbalance springs through an overcenter position. In Holmes, overhead door 1 is guided for movement relative to door frame by levers 6 and overhead tracks 4. More particularly, outer ends 8 of levers 6 are pivotally mounted to the lower ends of the door by brackets 9, while inner ends of levers 6 are pivotally mounted to brackets 5 at locations 7 slightly inboard of the levers' ends. The inner ends of levers 6 are also provided with compensating bars 12, as described at column 2, lines 11-21. The Holmes device also includes counterbalance springs 11 having upper ends connected to the door frame by brackets 10 and lower ends

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connected via links 25 to the compensating bars 12 at locations 26. Compensating bars 12 carry adjustable stop bolts 15 that engage the links 25 when the door is in the closed position, as shown in Figure 3. The adjustable stop bolts ensure that "the point of connection of the springs 11 with the compensating bars 12 is maintained at all times inside of the pivot 7 so that it is impossible for the point of connection of the spring 11 during movement of the door to pass over the center provided by the pivot 7" (column 2, lines 31-36).

In proposing to combine Carson and Holmes to reject claim 3, the examiner finds that Holmes "has a door, stays, and functions similar to Carson" (final rejection, page 3), and concludes that it would have been obvious

to have provided [in Carson] tension springs positioned between an upwardly and forwardly displaced location from a base ends [sic] of the stays and middle positions on the stays because doing so would have provided the advantage of urging the door toward the open position to provide easy lifting of the door when opening. [Final rejection, page 4.]

Initially, we note that the examiner has not specified

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what element or elements of Holmes correspond to Carson's lid stays 56. Presumably, the examiner equates the combination of levers 6 and compensating bars 12 of Holmes to Carson's stays 56, a proposition which we find to be, at best, strained. In any event, we find nothing in Holmes that corresponds to Carson's viscous dampers 50. Further, we find nothing in Holmes that corresponds to Carson's combination spring loaded hinge and slide mechanisms 26. In addition, in Holmes the door is stored within the compartment in the open condition rather than on top of the compartment as in Carson. Also, there is nothing in Carson that reasonably corresponds to the compensating bar 12 of Holmes, nor is there any apparent need in Carson for such compensating bars in that the Carson device relates to a relatively light door for

an overhead cabinet whereas the Holmes device relates to a relatively heavy door for a garage or the like (column 2, lines 2-7). For these reasons, we find the examiner's threshold determination that Holmes "functions similar to Carson" applies only when these references are viewed in the very general sense that both relate to an overhead door

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closure.

Concerning the examiner's position that it would have been obvious to have "provided" tension springs in Carson to afford easy lifting of the door when opening, it is not clear whether the examiner proposes to add counterbalance springs in Carson to supplement the springs 44 of Carson's hinge mechanisms 26, or whether the examiner proposes to replace springs 44 of Carson with counterbalance springs like those of Holmes. In either case, we do not view the combined teachings of the references as suggesting the incorporation of counterbalance springs in Carson between the lid stays and the inner lateral wall surfaces of the cabinet. In the first place, given that Carson's invention is directed to a relatively lightweight application of an overhead door as compared to that of Holmes, there is no apparent need for a complex counterbalance arrangement like that of Holmes in Carson. Further, assuming that the artisan would have been motivated to incorporate the counterbalance teachings of Holmes

in Carson, we consider that such incorporation would involve

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the addition of not only the tension springs of Holmes in Carson, but also the connecting link 25 and compensating bars 12, which, in our view, would not result in the subject matter of claim 3 since the springs would be connected to the compensating bars 12 via connecting links 25 rather than to the middle portions of the stays.

Where, as here, the prior art references require a selective combination of reference teachings to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). In the fact situation before us, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of Holmes to incorporate the counterbalance arrangement thereof into Carson in a manner that would have resulted in the subject matter of claim 3. We therefore shall not sustain the standing § 103 rejection of claim 3 as being unpatentable over Carson in view of Holmes.

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As to the standing § 103 rejection of claim 5, the tertiary Ferris reference additionally applied in this rejection does not render obvious what we have found to be lacking in the combined teachings of Carson and Holmes. Accordingly, we also shall not sustain the examiner's rejection of claim 5.

The decision of the examiner is reversed.

REVERSED

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IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
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LJS:hh

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